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10/584,649	06/26/2006	Dirk Gandolph	PDO40002	8142
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Joseph J. Laks Thomson Licensing LLC 2 Independence Way, Patent Operations PO Box 5312 PRINCETON, NJ 08543			EXAMINER DASGUPTA, SOUMYA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,649

Applicant(s)

GANDOLPH ET AL.

Examiner

SOUMYA DASGUPTA

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's Response

In the applicant's response for application 10/584,649 dated 9/26/2008, the applicant amended Claims 1, 5, 6, 13, and 15; and added new Claims 16-20; and argued against all the rejections and objections.

The Objection set forth for Claim 15 is withdrawn because the appellant discloses the recital of an "optical storage medium" in the Specification.

Claims 1-20, as originally filed, are currently pending and have been considered below.

Claims 1, 13, and 15 are independent claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20:

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitation "associating a numeric page number" [emphasis added] (see Line 5) and "defining a numeric page number" [emphasis added] (see Line 9). There is no mention in the original Specification of "numeric page number."

Claim 13 recites the limitation "detecting a numeric value" [emphasis added] (see Line 5) and "allowed numeric page numbers" (see Lines 8-9). There is no mention in the original Specification of "multimedia page number."

If the examiner has overlooked the portions of the original Specification that describes these features of the present invention, then Applicant should point it out (by page number and line number) in the response to this Office Action.

Applicant may obviate these rejections by canceling the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 17:

Claims 5 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

The phrase "number from among the available menu pages within the defined range the next higher page number relative to the page number of said first menu page is selected if the numeric value indicates a higher page number than the page number

of the first menu page” is confusing and not clearly understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims * are rejected under 35 U.S.C. 102(b) as being anticipated by Goldsmith et al (US 2005/0076309; PG Pub Date: April 7, 2005; Patent Filing Date: Oct 3, 2003; hereafter Goldsmith.)

Claim 1:

Goldsmith discloses:

A method for automatically generating an electronic menu including a plurality of menu pages, wherein menu pages contain selectable menu items with associated commands to be executed upon activation of the respective menu item, the method comprising: (Fig 5→ Goldsmith discloses “automatically generating an electronic menu including a plurality of menu pages” in that a list of categories are produced in a menu-like system. Fig 5 → Goldsmith discloses “menu pages contain selectable menu items with associated commands to be executed upon activation of the respective menu item” in that the user can click on the hyperlink from the tree-menu.

wherein associating a numeric page number with each menu page; (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "associating a numeric page number with each menu page" in that each menu selection has a pointer associated with it. The forward pointer allows navigation to a successive menu and the backward pointer allows navigation to a previous menu. According to Fig 5, the user can navigate between successive and previous menus. Moreover, the examiner notes that "numeric page numbers" are functionally equivalent to pointers to other menus because the applicant is referring to *Fig 1, item 14 of the application* as the "numeric page number" (Playlist #xxxx). The Playlist numbers refers to the current menu and points successive and previous menus pending on the user's selection.)

a first menu page containing at least one menu item with an associated command and associated data, wherein the command associated with the menu item comprises switching to another menu page; (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "a first menu page containing at least one menu item with an associated command and associated data, wherein the command associated with the menu item comprises switching to another menu page" in that the user can select the items from a menu to either view more submenus or initiate a command for a function. According to Fig 5, the user can navigate between successive and previous menus. Moreover, the examiner notes that "numeric page numbers" are functionally equivalent to pointers to other menus because the applicant is referring to *Fig 1, item 14 of the application* as the "numeric page number" (Playlist #xxxx). The Playlist numbers refers

to the current menu and points successive and previous menus pending on the user's selection.)

defining a numeric range of page numbers based upon said data associated with said command; (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "defining a numeric range of page numbers based upon said data associated with said command" in that the menu contains a list of selections of a sub-menu because the page numbers are functionally equivalent to pointers that designate a selection or a new sub-menu. The examiner interprets "range of page number" to be of selection items on the current menu. Since "page numbers" are functionally equivalent to pointers of the listed selections items on the menu, then the listed selection items on the menu are functionally equivalent to a "range of page numbers" or a range of pointers.)

detecting the page numbers of the available menu pages; (Fig 5 → Goldsmith discloses "detecting the page numbers of the available menu pages" in that the whenever a new selection is made, the pointer detects and points to the new menu page so that the new menu can be opened. If a pointer was not available, the new menu selected would not be able to open.)

and selecting a second menu page upon activation of said menu item for switching to another menu page, (Fig 5, Paragraphs [0010] and [0011] → Goldsmith

this limitation in that the user can select a menu item that can open another menu page.)

wherein the second menu page has the first or last page number from among the available menu pages within the defined range of menu pages (Fig 5, Paragraphs [0010] and [0011] → Goldsmith this limitation in that the user can select a menu item that can open another menu page. The selected menu can have a pointer to the first menu or be a child menu without any offspring.)

and wherein the first and second menu pages are retrieved from different storage media. (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "the first and second menu pages are retrieved from different storage media" in that the audio player, QuickTime player, and camera tools can be from different storage devices.)

Claim 2:

Goldsmith discloses:

Method according to claim 1, wherein defining a range of page numbers is also based upon the page number of said first menu page. (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "defining a range of page numbers is also based upon the page number of said first menu page" in that the menu contains a list of selections of a sub-menu because the page numbers are functionally equivalent to

pointers that designate a selection or a new sub-menu. The examiner interprets "range of page number" to be of selection items on the current menu. Since "page numbers" are functionally equivalent to pointers of the listed selections items on the menu, then the listed selection items on the menu are functionally equivalent to a "range of page numbers" or a range of pointers. The user can select the first menu by selecting "launch app>" (see Fig 5).)

Claim 3:

Goldsmith discloses:

Method according to claim 2, wherein said range is further defined by a page number of another menu page that is stored on the same storage medium as the first menu page. (Fig 5 → Goldsmith discloses "range is further defined by a page number of another menu page that is stored on the same storage medium as the first menu page." in that the whenever a new selection is made the menu of the application can be from the same storage device.)

Claim 4:

Goldsmith discloses:

Method according to claim 1, wherein said range is defined by a placeholder within said data associated with said command. (Fig 5 → Goldsmith discloses "range is defined by a placeholder within said data associated with said command" in

that the pointer is programmed into memory so that the user can select the appropriate navigation options.)

Claim 5:

Goldsmith discloses:

Method according to claim 1, wherein said data associated with said contain a numeric value and wherein the range of page numbers is defined by the numeric value and the page number of said first menu page, (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "data associated with said contain a numeric value and wherein the range of page numbers is defined by the numeric value and the page number of said first menu page" in that the pointers can be designated with alpha-numeric code.)

and wherein number from among the available menu pages within the defined range the next higher page number relative to the page number of said first menu page is selected if the numeric value indicates a higher page number than the page number of the first menu page. (Fig 5, Paragraphs [0010] and [0011] →

Examiner Interpretation: Goldsmith discloses "wherein number from among the available menu pages within the defined range the next higher page number relative to the page number of said first menu page is selected if the numeric value indicates a higher page number than the page number of the first menu page" in that the user can select successive or previous menus. According to Figure 13 of the Application, the

"higher page numbers" are the successive menus of the root menu and the "lower page number" are the root menu.)

Claim 6:

Goldsmith discloses:

Method according to claim 1, wherein a menu page is stored in a separate file, or in a selectable portion of a file, and the page number is determined by the name of the file, or by the name of the file and the selectable portion within the file, in which it is stored. (Fig 5 → Goldsmith discloses "menu page is stored in a separate file, or selectable portion of a file, and the page number is determined by the name of the file, or the name of the file and the selectable portion within the file, in which it is stored" in the hardware in the computer stores the menu is a cache memory or permanent storage either within the software itself or in a separate file designating a menu.)

Claim 7:

Goldsmith discloses:

Method according to claim 1, wherein the page number associated with the first or second menu page depends on user specific settings. (Fig 5 and 7 → Goldsmith discloses "the page number associated with the first or second menu page depends on user specific settings" in that the user can select the item on the menu that is specified

to the user's settings. The user's settings can select features that can be added to the menu. Fig 7, item 504 → "Personal Info Manager" and "System")

Claim 12:

Goldsmith discloses:

Method according to claim 1, wherein detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available. (Fig 5; Fig 7, item 504 → Goldsmith discloses " detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available" in that a multimedia feature such as QuickTime or Audio player can be selected.)

Claim 13:

Claim 13 corresponds to Claim 1.

Claim 14:

Claim 14 corresponds to Claim 5.

Claim 15:

Goldsmith discloses:

Optical storage medium for storing audio-visual content and menu data for a multi-page menu, wherein menu pages have page numbers, and wherein at least a first menu page contains a command for selecting a second menu page, (Figs 5 and 7; Paragraph [0010] and [0011] → Goldsmith discloses this limitation in that the AV data can be selected from the menu and the root menu contains a selection that can navigate to the second page.)

wherein the command for selecting a second menu page specifies a numeric range of two or more menu pages to select, and a predefined rule specifies which menu page of the numeric range of menu pages is selected next; (Figs 5 and 7; Paragraph [0010] and [0011] → Goldsmith discloses " the command for selecting a second menu page specifies a numeric range of two or more menu pages to select, and a predefined rule specifies which menu page of the numeric range of menu pages is selected next" in that each menu selection has a pointer associated with it. The forward pointer allows navigation to a successive menu and the backward pointer allows navigation to a previous menu. According to Fig 5, the user can navigate between successive and previous menus. Moreover, the examiner notes that "numeric page numbers" are functionally equivalent to pointers to other menus because the applicant is referring to *Fig 1, item 14 of the application* as the "numeric page number" (Playlist #xxxx). The Playlist numbers refers to the current menu and points successive and previous menus pending on the user's selection.)

and for at least one page number within said range no relating menu page is stored on the optical storage medium. (Figs 5 and 7 → Goldsmith discloses "at least one page number within said range no relating menu page is stored on the optical storage medium" in that hardware in the computer stores the menu is a cache memory or permanent storage either within the software itself or in a separate file designating a menu. The examiner notes that the limitations refer to data NOT being stored.)

Claim 16:

Claim 16 corresponds to Claim 4.

Claim 17:

Claim 17 corresponds to Claim 5.

Claim 18:

Claim 18 corresponds to Claim 6.

Claim 19:

Claim 19 corresponds to Claim 7.

Claim 20:

Claim 20 corresponds to Claim 12.

Response to Arguments

Claim (5 and 17) Rejection under 35 USC 112 (2nd Paragraph):

The appellant argues that the limitation “wherein number from among the available menu pages within the defined range the next higher page number relative to the page number of said first menu page is selected if the numeric value indicates a higher page number than the page number of the first menu page” is not confusing and the rejection should be withdrawn. The appellant attempts to further clarify the meaning on the limitation on the Applicant's Arguments (pg 5-6) dated 9/26/2008.

The examiner disagrees.

The examiner has noted the appellant's attempt to clarify the meaning of the limitation, the limitation as currently recited is still confusing and not easily understood by one of ordinary skill in the art; however, the explanation of this confusing limitation is not sufficient and does not obviate a 112(2nd paragraph) rejection. The examiner HIGHLY RECOMMENDS that the appellant amend the limitation in order to CLARIFY its meaning.

Claim (1-7 and 12-15) Rejection under 35 USC ~ 102(b):

The appellant argues that Gordon (US 2002/0013944) does not disclose "numeric page numbers" from Claims 1, 13, and 5. Applicant's arguments with respect to claims 1, 13, and 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SOUMYA DASGUPTA whose telephone number is

(571)272-7432. The examiner can normally be reached on M-Th 9am-7pm, F 9am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7432.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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